

REMARKS

Claims 15, 16, 25, 30 and 35 are canceled without prejudice, and claims 11 to 14, 17, 19 to 24, 26 to 29, and 31 to 34 are now pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph six (6) of the Final Office Action, Applicants thank the Examiner for indicating that claims 16, 25, 30 and 35 contain allowable subject matter. While the objections may not be agreed with, to facilitate matters, claim 11 has been rewritten to include the features of claim 16 (and of claim 15 from which it depends), and claims 15 and 16 have been canceled without prejudice. Accordingly, claim 11 is allowable, as are its dependent claims. Also, claim 19 has also been rewritten to include the features of original claim 25 (which has been canceled without prejudice), so that claim 19 is allowable, as are its dependent claims. Also, claim 27 has been rewritten to include the features of original claims 19 and 30, so that claim 27 is allowable, as are its dependent claims. Finally, claim 32 has been rewritten to include the features of original claims 11 and 35, so that claim 32 is allowable, as are its dependent claims. Accordingly, claims 11 to 14, 17, 19 to 24, 26 to 29, and 31 to 34 are allowable. It is therefore respectfully requested that the objections be withdrawn.

With respect to paragraph four (4) of the Final Office Action, claims 11, 12, 14, 15, 19 to 21, 23 and 24 were rejected under 35 U.S.C. § 102(b) as anticipated by Chen, U.S. Patent No. 6,160,369.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(a), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claim 11 has been rewritten to include the features of claim 16 (and of claim 15 from which it depends), and claims 15 and 16 have been canceled without prejudice. Accordingly, claim 11 is allowable, as are its dependent claims. Also, claim 19 has also been rewritten to include the features of original claim 25 (which has been canceled without prejudice), so that claim 19 is allowable, as are its dependent claims. Also, claim 27 has been rewritten to include the features of original claims 19 and 30, so that claim 27 is allowable, as are its dependent claims. Finally, claim 32 has been rewritten to include the features of original claims 11 and 35, so that claim 32 is allowable, as are its dependent claims. Accordingly, claims 11 to 14, 17, 19 to 24, 26 to 29, and 31 to 34 are allowable. It is therefore respectfully requested that the rejections be withdrawn.

With respect to paragraph five (5) of the Final Office Action, claims 13, 17, 22, 26 to 29, 31 to 34 and 36 were rejected under 35 U.S.C. § 103(a) as obvious over Chen, U.S. Patent No. 6,160,369, in view of Stam et al., U.S. Patent No. 5,923,027.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with, to facilitate matters, claim 11 has been rewritten to include the features of claim 16 (and of claim 15 from which it depends), and claims 15 and 16 have been canceled without prejudice. Accordingly, claim 11 is allowable, as are its dependent claims. Also, claim 19 has also been rewritten to include the features of original claim 25 (which has been canceled without prejudice), so that claim 19 is allowable, as are its dependent claims. Also, claim 27 has been rewritten to include the features of original claims 19 and 30, so that claim 27 is allowable, as are its dependent claims. Finally, claim 32 has been rewritten to include the features of original claims 11 and 35, so that claim 32 is allowable, as are its dependent claims. Accordingly, claims 11 to 14, 17, 19 to 24, 26 to 29, and 31 to 34 are allowable. It is therefore respectfully requested that the rejections be withdrawn.

In sum, it is respectfully submitted that claims 11 to 14, 17, 19 to 24, 26 to 29, and 31 to 34 are allowable.

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CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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